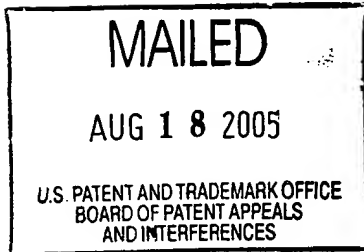


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD WISNIEWSKI

Appeal No. 2005-1947
Application No. 09/579,846

ON BRIEF

Before KIMLIN, PAK and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2, 3, 6-9 and 18-21. Claim 18 is illustrative:

18. A method for thawing a frozen biopharmaceutical solution, the method comprising:

heating the biopharmaceutical solution, when at least a portion of the biopharmaceutical solution is frozen, using a heating element coupled to a container which contains the biopharmaceutical solution; and

inducing oscillatory motion to the biopharmaceutical solution to thaw the at least a portion of the biopharmaceutical solution using an oscillatory driver adapted to be coupled to the biopharmaceutical solution; and

wherein the driver inducing the oscillating motion rolls the container from a first position to a second position along, and in contact with a surface, and the

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driver rolls the container a distance from the second position toward the first position along, and in contact with, the surface.

The examiner relies upon the following references as evidence of obviousness:

Baldus et al. (Baldus)	4,178,776	Dec. 18, 1979
Schmidt	5,999,701	Dec. 7, 1999
Scheiwe et al. (DE '784) (German patent)	30 47 784	Jul. 1, 1982
Nabeya (JP '831) (Japanese Kokai Patent Application)	Sho 63-296831	Dec. 2, 1988
Nabeya (JP '138) (Japanese Published Unexamined Patent Application)	02-187138	Jul. 23, 1990
Umetsu (JP '371) (Japanese Kokai Patent Application)	Hei 2-261371	Oct. 24, 1990

Richard Wisniewski & Vincent L. Wu (Wisniewski), "Large-Scale Freezing and Thawing of Biopharmaceutical Drug Product," Proceedings of the International Congress 132-140 (February 1992)

L. Quan et al. (Quan), "Effects of Vibration on Ice Contact Melting Within Rectangular Enclosures," 120 Transactions of the ASME 518-520 (May 1998)

Appellant's claimed invention is directed to a method for thawing a frozen biopharmaceutical solution by imparting heat and oscillatory motion to the solution. A driver induces the oscillating motion by rolling the container that holds the solution from a first position to a second position and back from the second position to the first position. The container is in contact with the surface along which it rolls.

Appealed claims 2, 3, 6-9 and 18-21 stand rejected under 35 U.S.C. § 112, first paragraph. The appealed claims also stand rejected under 35 U.S.C. § 103(a) as follows:

(a) claims 2, 9 and 18-21 over Wisniewski in view of JP '831, JP '138 or JP '371;

(b) claims 3 and 6-8 over the combination of references stated in (a) above further in view of Baldus;

(c) claims 6-8 over the combination of references stated in (a) above further in view of Schmidt;

(d) claims 6-8 over the combination of references stated in (a) above further in view of DE '784; and

(e) claims 6-8 over the combination of references stated in (a) above further in view of Quan.

Appellant submits at page 5 of the principal brief that "claims 2-3 and 6-9 stand or fall with claim 18." Also, while appellant separately groups claims 19, 20 and 21, the examiner correctly states that only claim 20 has been separately argued (see page 3 of Answer).

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we find that the examiner's rejection under § 112, first paragraph, is not well-founded. However, we are in complete agreement with the

examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

We consider first the examiner's rejection of the appealed claims under § 112, first paragraph. It is the examiner's position that the original specification does not provide descriptive support for the recitation in claims 18-21 that the container rolls along, and in contact with, a surface. According to the examiner, the rolling is performed by rollers attached to the container, but not by the container itself. However, although we agree with the examiner that Figure 1 of appellant's specification does not make it clear whether the wheels of the wheeled container are integral with or separate from the container, we concur with appellant that one of ordinary skill in the art would have understood that the original specification reasonably conveys the concept that the container rolls on a surface with which it has at least indirect contact through the wheels and the support structure. We note that appellant acknowledges that "the 'wheeled container' signifies to a reader that the wheels may be part of the container" (page 2 of Reply Brief, last paragraph, emphasis added). As such, we agree with appellant that the specification conveys that the wheels may be

part of and integral with the container or a separate structure therefrom on which the container is supported.

We now turn to the examiner's rejections under § 103. As noted by the examiner, appellant has not contested any of the factual findings with respect to the Wisniewski disclosure, nor has appellant contested the examiner's legal conclusion that:

To have used the shaker platform of JP '831 or JP '138 or JP '371 to oscillate the 1992 tank of Wisniewski and Wu back and forth on rollers to effect faster thawing of the frozen product during the thawing phase would have been obvious given the advantages of the "simple mechanisms" and "low cost" of these shaker platforms.

(See sentence bridging pages 6 and 7 of examiner's Final rejection of September 29, 2003). Rather, appellant stresses that even when the combined teachings of the references are used to oscillate the tank of Wisniewski, the tank does not roll "along, and in contact with, a surface" (page 3 of principal brief, first paragraph, emphasis added). It is appellant's position that the rolling wheels of the three Japanese references would not be part of the container of Wisniewski and, therefore, the container or tank of Wisniewski would not be in contact with the surface upon which the wheels or rollers roll. However, as explained in our discussion of the § 112, first paragraph rejection, neither the appealed claims nor the specification

requires that the wheels which roll on the surface are an integral part of the container. Indeed, the claims do not recite a wheeled container. Hence, although appellant's argument is based on the premise that the claims require the container, itself, to roll on and be in contact with a surface, such direct contact between the container and the surface is not required by the claim language. In our view, the claims encompass indirect contact between the container and the surface that is afforded by a separate, supporting wheeled structure. Moreover, even if the appealed claims required direct contact between the container and the surface, we are satisfied that it would have been obvious for one of ordinary skill in the art to forego the shaker platforms of the prior art for a simple means of oscillating the container on rollers that are either separate from or integral with the container. Also, we find that it would have been obvious for one of ordinary skill in the art to construct the rolling platform of the prior art in unison with the container.

In essence, appellant's arguments are not commensurate in scope with the degree of protection sought by the appealed claims. Also, we note that appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results,

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which would serve to rebut the inference of obviousness established by the applied prior art.

In conclusion, the examiner's rejection under 35 U.S.C. § 112, first paragraph, is reversed. The examiner's rejections under 35 U.S.C. § 103(a) are sustained for the reasons well-stated by the examiner and those set forth above. Consequently, the examiner's decision rejecting the appealed claims is affirmed.


No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

Edward C. Kimlin
EDWARD C. KIMLIN
Administrative Patent Judge

CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


CHARLES F. WARREN
Administrative Patent Judge

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